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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/587,983

08/03/2006

Hideto Nabemoto

1391.1074

8241

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STAAS & HALSEY LLP
SUITE 700
1201 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER

RAMOS, JAVIER J

ART UNIT

PAPER NUMBER

2625

MAIL DATE

DELIVERY MODE

07/20/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<p align="center">Advisory Action Before the Filing of an Appeal Brief</p>	<p>Application No. 10/587,983</p>	<p>Applicant(s) NABEMOTO ET AL.</p>	
	<p>Examiner JAVIER J. RAMOS</p>	<p>Art Unit 2625</p>	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 30 June 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-5,7,9 and 11.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Mark K Zimmerman/
Supervisory Patent Examiner, Art Unit 2625

Continuation of 11. does NOT place the application in condition for allowance because: The arguments presented by the Applicant in regards to claims 1-5, 7, 9 and 11 are not persuasive and therefore the current rejection presented on 5/1/09 stands.

The Applicant generally argues on page 5, lines 27-32 that, "[t]he cited references, alone or in combination, do not discuss or suggest: an image reading unit configured to receive a medium including a colorless and transparent carrier sheet that includes a combination instruction mark in a predetermined position thereon and holds an original therein and configured to read a front side image and a rear side image from a front side and a rear side of the original." More specifically, the Applicant argues in particular against Tomita et al. teaching "a carrier sheet that is transparent and colorless." It is noted by the Examiner however, that the Applicant did not specifically state what elements of the carrier sheet are transparent and colorless and also that the Applicant's own carrier sheet is not entirely transparent and colorless due to the usage of at least the combination instruction mark on the sheet. Therefore, since the carrier sheet of Tomita contains a transparent sheet, as detailed in [0044], it therefore can be considered transparent.

The Applicant further argues on page 6, paragraph 2 that, "the carrier sheet of Tomita et al. does not allow a scanning apparatus to read both a front side image and a rear side image from a front side and a rear side of the original document." The Examiner notes that the Tomita reference was not relied upon in the previously presented rejection to teach this limitation. Therefore, this argument does not apply to the Tomita reference. Further, since the Tomita reference is used in a 103 combination with the Tamagaki and Kanno references, it is reasonable to assume that the Tomita reference would be modified to fit with the teachings of the previously relied upon references so that the carrier sheet as a whole would be able to read both sides of a document, as taught specifically by Kanno. The Tomita reference was specifically relied upon only to teach a transparent carrier sheet and not the reading of both sides of a inputted sheet.

Finally, the Applicant argues that, "there is no motivation for combining the references because the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose." In response to Applicant's argument that there is no motivation to combine the references, the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the Tomita reference being combined with the Tamagaki and Kanno references was relied upon to solely teach the use of a transparent carrier sheet that contained instruction marks and therefore the combination of these references with respect to the teaching of Tomita would not modify Tamagaki, as modified by Kanno, in a manner that was unsatisfactory for its intended purpose of scanning and processing documents.